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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

MAILED

APR 1 8 2007

Group 3700

Application Number: 10/606,250
Filing Date: June 24, 2003
Appellant(s): GARABEDIAN ET AL.

Michael J. Bolan
For Appellant

**EXAMINER'S ANSWER**

This Examiner's Answer is supplemental to the Answer mailed January 30, 2007 ultimately appealing from the Office action mailed November 3, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

| | | |
|---|---|---|
| 6,530,922 | Cosman et al | 3-2003 |
| 2002/0120261 | Morris et al | 8-2002 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 23-27, 29, 33-39, 44, 48, 49 and 70-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman et al (6,530,922).

The Cosman et al device includes an alignment device (14) fixed to an external tissue surface. The alignment device includes a plurality of apertures (14a) through which ablation probes are provided to create lesions in tissue. The device is used to create an enlarged, complete, compound lesion in tumor tissue located beneath the skin, and the probes may be provided to tissue in parallel or non-parallel configurations (see Figures 9a-9c). Cosman et al also disclose the use of various sets of probes (Figures 5-6) and the use of a cannula to provide the probes to tissue (Figure 7). Cosman et al fail to teach providing a first probe in a first aperture to create a first lesion, then removing the probe and placing it in a different aperture to create a second lesion as recited in applicant's claim 23. Cosman et al further fail to disclose the sequential operation of the probes as recited in applicant's claim 35. Rather, Cosman et al provide the probes into tissue and provide RF energy to the probes simultaneously to provide more efficacious creation of lesions in tissue. However, Cosman et al specifically teach that it is (was) known to provide for the creation of individual lesions and to provide sequential heating with various probes. In particular, column 4, lines 12-46 discuss the benefits of providing energy to the electrode cluster as opposed to providing energy to single probes or providing energy sequentially or serially to a plurality of probes. As such, Cosman et al is deemed to specifically teach that it is well-

known in the art to use single probes activated sequentially or serially to create multiple, compound lesions for the treatment of tissue. Cosman et al specifically provide for an improvement in those procedures.

As such, it is deemed to be an obvious consideration for one of ordinary skill in the art to have created multiple lesions in tumor tissue with a single probe or a plurality of probes that are activated either serially or sequentially, particularly since Cosman et al teach that such a procedure is known in the art.

Claims 28 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman et al ('922) as applied to the claims above, and further in view of Morris et al (2002/0120261).

The Cosman et al device has been addressed previously. Cosman et al provide a skin-surface alignment device, but fail to provide the particular bosses or recesses on the device to control the deployment distance of the ablation probe.

Morris et al disclose an analogous ablation probe device that provides an alignment device including a plurality of apertures through which ablation probes are inserted to treat tumor tissue. In particular, Morris et al disclose various embodiments to control the deployment of the ablation probes. Figures 22, 39, 40 and 50B show various bosses and recesses used to control the distance the ablation probes are deployed from the alignment device.

To have provided the Cosman et al device with a boss or recess associated with the apertures to control the deployment distance of the ablation probes is deemed an obvious consideration for one of ordinary skill in the art since Morris et al

teach that it is known to use such a means to control the deployment of ablation probes through an alignment device.

**(10) Response to Argument**

1) Claims 35-38, 44, 48, 49, 72, 73 and 81

Applicant contends that Cosman specifically teaches away from the steps of sequentially delivering energy to tissue with a single probe in favor of using a plurality of probes that are simultaneously activated to create a single, large lesion. The point that Cosman is teaching the simultaneous delivery of energy to a plurality of probes is indisputable. However, the examiner maintains that while Cosman may teach and adamantly hold that the creation of a single, larger lesion with a plurality of simultaneously actuated probes yields a superior result, this teaching does not mitigate the fact that it is known to create a larger lesion through the use of serially or sequentially activated probes. Applicant has readily admitted at page 5, first full paragraph, of the Brief that it is known to create lesions using serially or sequentially activated probes. The examiner stands by the position that while Cosman may teach that it is preferable to create a single, large lesion using simultaneously activated probes, Cosman also teaches that it is known to create multiple lesions using serially or sequentially activated probes. Cosman may teach that it is less desirable to use serially or sequentially activated probes, but it doesn't erase the fact that it is known or would be obvious to do so.

2) Claims 23-26, 29, 33, 34 and 78

Claim 23 specifically requires the same probe to be placed in different apertures to create first and second lesions. The examiner maintains that one of ordinary skill in the art would recognize that operating a single probe in a plurality of locations would be an obvious alternative to placing a plurality of probes and then activating the plurality of probes sequentially to create a plurality of lesions. As addressed in the previous section, the examiner maintains that while Cosman teach that it is more preferable to create one larger lesion with a plurality of simultaneously activated probes, it does not obviate that it is clearly known to those of ordinary skill in the art to serially or sequentially activate the probes to create a series of individual lesions.

3) Claims 70, 71, 74 and 75

These claims call for a cannula to provide the electrodes to tissue. Applicant contends that Cosman specifically teaches away from the use of a cannula to deliver multiple electrodes and has recited a particular passage from the patent to support this assertion. It is the examiner's position that the quoted passage is taken out of context. Cosman discloses the use of the stereotactic guide to deliver the plurality of electrodes to treat very large lesions of up to 4-6 mm and does teach that the device is preferable to "side-emitting" electrode devices. However, Cosman also specifically disclose an embodiment (Figure 7) that includes a sheath, or cannula, to deploy a smaller number of electrodes to a tumor. As such, the examiner maintains that the use of a cannula to delivery the electrode(s) in Cosman does not render the device unsatisfactory for its intended purpose, as posited by the applicant, since Cosman clearly anticipate the use

of the device in a variety of environments that would required alternate deployment means.

4) Claims 76, 77, 79 and 80

These claims recite an alignment device affixed to the skin of the patient. Applicant contends that Cosman teaches away from this since the small needles are directed into an organ, and if the alignment device were placed on the skin the needles would not be suitable for percutaneous treatment of tumors. The examiner disagrees. While Cosman specifically addresses the treatment of liver tumors, this is but an example. The Cosman reference states that the device is to treat tumors in any organ on a human body (col. 5, lines 65-67). Skin tissue is an organ of the body, and one of ordinary skill in the art would obviously recognize that tumors located just under the skin tissue (or within the skin tissue) may advantageously be treated with the Cosman device. Moreover, the examiner maintains that securing the device to the skin tissue to prevent movement during the procedure would be an intuitive and obvious consideration for the user of such a device. As such, the examiner maintains that the rejection of these claims is tenable.

5) Claims 28 and 40-43

Applicant has not substantively argued these claims other than to assert that the Morris reference does not overcome the deficiencies of the Cosman teaching. As asserted previously, the examiner maintains that the Cosman teaching is not lacking in the relevant teaching that it is indeed known to sequentially activate the electrode members, regardless of the benefits Cosman discloses in activating the probes

simultaneously. The examiner maintains that the combination of the Morris et al teaching with the Cosman reference is a tenable rejection.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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